

**REMARKS**

Reconsideration and removal of the grounds for rejection are respectfully requested. Claims 1, 3, 4, 6, 7 and 10-27 were in this application, claim 14-27 were withdrawn in response to a restriction requirement, claims 1 and 3 have been amended.

Claims 1, 3, 4, 6, 7 and 10-13 were rejected as being indefinite as claim 1 was considered unclear relative to the amount of aloe extract encompassed by the claim. The intent of the original language was to assure an active range of acemannan in the composition, with different aloe vera extracts. Claims 1 and 3 have now been amended to recite directly the range of acemannan present, relative to the extract containing 25% acemannan, and these claims are now believed to be definite.

Entry of this amendment after final is respectfully requested as placing the application in condition for allowance and/or reducing the issues on appeal. This amendment does not add any elements to claims 1 or 3. Rather, the claims have been amended to clarify the range of acemannan inherent in the original claim language. More positively reciting the amount of acemannan does not require a new search nor raise new issues. The amendment also renders moot the rejections over the prior art, placing the application in condition for allowance, as discussed more fully below.

Claims 1, 4, 12 and 13 were rejected as being anticipated by U.S. Patent Publication No. 2003/0084912 in light of the CSL website, relative to inherency.

Claim 1 clearly recites a specific combination of ingredients not found in the cited prior art. That various ingredients are listed in a long list in one reference does not establish that the claimed combination of the invention is anticipated. In fact, the contrary is true for the elements of claim 5 referenced by the examiner include a tobacco element, not present in the claimed invention.

To find anticipation, each and every element of the claim must be found in a single prior art reference. W.L. Gore & Associates, Inc. v. Garlock, Inc. 220, U.S.P.Q. 303 (Fed. Cir. 1983). The Federal Circuit has consistently held that anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. In re Bond,

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910 F.2d 831 (Fed. Cir. 1990); Atlas Powder Co. v. E.I. Por. de Nemours & Co., 750 F.2d 1569 (Fed. Cir. 1984). The Federal Circuit has also stated that "even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it is not enabling." In re Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985) (citing In re Borst, 345 F.2d 851, 855 (C.C.P.A. 1965, cert. denied, 382 U.S. 973 (1966), Seymour v. Osborne, 78 U.S. (11 Wall.) 516, 555 (1870) (publication constitutes anticipation only if it enables one skilled in the art "to understand the nature and operation of the invention, and to carry it into practical use,")).

Clearly, there is nothing in the '912 publication which would enable one to practice the applicants invention, as all the compositions include a tobacco element. Consequently, these claims are not anticipated by the cited reference.

Claims 1, 3, 4, 6, 7 and 10-13 were rejected as being obvious over Betterlife.com, U.S. Patent nos. 5,977,073 and 6,592,908.

In order to uphold a finding of obviousness, there must be some teaching, suggestion or incentive for doing what the applicant has done. ACS Hospital Sys. Inc. v. Montefiori Hospital, 723 F.2d 1572 (Fed. Cir. 1984). Also, "Both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure." In re Dow Chemical Co., 837 F.2d 469 (Fed. Cir. 1988).

The Patent and Trademark Office has the burden under section 103 to establish a prima facie case of obviousness. In re Piasecki 223 USPQ 2d 785 (Fed. Cir. 1984). They can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to an ordinary skill in the art would lead the individual to combine relevant teachings of the references. In re Fine, 837 F.2d 1071 (Fed. Cir. 1988).

While individually, the ingredients may be known in the art, "it is irrelevant in determining obviousness that all other aspects of the claimed invention are well known in a piecemeal manner, in the art, since virtually every patent can be described as a 'combination patent', or a 'combination of old elements'. The mere fact that the disclosure of teachings of the prior art can be retrospectively combined for purposes of evaluating the obviousness/non-obviousness issue does not make the combination obvious unless the art also suggested the desirability of the combination or the inventor's beneficial results of the advantage to be derived

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from the combined teaching." Fromson v. Advanced Offset Plate, Inc. 755 F. 2d 1549, 1556 (Fed. Cir. 1985). At best it might be obvious to try various combinations, but obvious to try is not the standard.

A relevant case is In re Fine, 5 U.S.P.Q. 2d 1596 where the CAFC reviewed an obviousness rejection where the claimed invention, a system for detecting and measuring nitrogen compounds was considered obvious in view of a similar system used for monitoring sulfur compounds, combined with a disclosure of a nitrogen detector. The Court held "The Eads and Warnick references disclose, at most, that one skilled in the art might find it 'obvious to try' the claimed invention. But whether a particular combination might be 'obvious to try' is not a legitimate test of patentability (cite omitted)..." teachings of references can be combined only if there is some suggestion or incentive to do so" Id. at 1599. The Court also held that the Board failed to recognize that an advantage of the invention was not appreciated by the prior art, i.e., a temperature limitation which prevented measurement distortion. Id at 1600.

These cases are similar to the present case, as there is no teaching or suggestion for combining the components of claim 1 together, or any indication of any advantage to making such a combination. As the Court stated in Fine:


"The Examiner relies on hindsight in reaching his obviousness determination. But the court has said, 'To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. W.L. Gore, 721 F. 2d at 1553, 22 USPQ at 312-13. It is essential that decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made...to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art. Id. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention. In re Fine F. 2d 1071, 1075 (Fed. Cir. 1988).

The applicants' invention is an oral composition formulated for oral administration, and containing specific ingredients, in specific ranges which solves a problem, alleviating the symptoms of upper intestinal tract discomfort. There is no teaching or suggestion for preparing

such a mixed composition in the cited references, not any indication of the advantages obtained using the composition. Consequently, claims 1, 3, 4, 6, 7 and 10-13 are not obvious, and this rejection should be withdrawn.

Based on the above remarks, favorable consideration and allowance of the application is respectfully requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

  
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